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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/495,186 02/01/00 MCMICHAEL

J 13024/35946

EXAMINER

HM12/1010

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WILSON, M

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/495,186Applicant(s)
McMichael et al.Examiner
Wilson, Michael C.Art Unit
1633

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED Sep 24, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY (check only a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attached

4. ☒ Applicant's reply has overcome the following rejection(s):
the double patenting rejection of claims 8-14 over 6,100,244
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-20
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

MICHAEL C. WILSON
PATENT EXAMINER

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The amendment filed 9-24-01, paper number 13, has not been entered because it introduces subject matter that would require considerations not previously required.

The phrase "allergy symptoms not associated with respiratory congestion selected from the group consisting of headache, irritated eyes and lethargy" would require considerations regarding enablement and indefiniteness not previously required.

The phrase "asthma symptom of constriction of the airways which is not associated with respiratory congestion" would require new considerations regarding enablement and indefiniteness not previously required.

Applicants argue that the Declaration of April 20, 2001 states that Examples XXXI-XXXIII are not prophetic and reflected work actually done. Applicants argument is not persuasive because neither the declaration or Examples XXXI-XXXIII teach what symptoms were reduced. Therefore, claims 1-7 remain not enabled for reasons of record.

Applicants argue that two types of pulmonary diseases were known in the art - those in which large amounts of sputum are produced and those which have chronic expiratory airflow limitations. Applicants argument is not persuasive because chronic production of large amounts of sputum can cause chronic expiratory airflow. Therefore, claims 8-14 remain not enabled for reasons of record.

Claims 1-15 and 20 remain rejected under 112/2nd for reasons of record. Applicants arguments regarding the amendments to the claims are moot because the amendment has not been entered.

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The rejection of claims 8-14 under 102(e) as being anticipated by McMichael ('244, '442, '160 and '721) has been withdrawn because Allen contributed to the treatment of otitis media and not to the treatment of asthma.

Claims 1-7 remain rejected under 103 for reasons of record. Applicants arguments regarding the 103 rejection of claims 1-7 are dependent upon the newly suggested language limiting the symptoms of respiratory congestion to headache, irritated eyes and lethargy. Applicants arguments are moot because the amendment has not been entered.

Claims 1-7 remain rejected under double patenting for reasons of record. Applicants arguments regarding the double patenting rejection of claims 1-7 are dependent upon the newly suggested language limiting the symptoms of respiratory congestion to headache, irritated eyes and lethargy. Applicants arguments are moot because the amendment has not been entered.

Claims 8-14 remain rejected under double patenting over McMichael 5,726,160 in view of Murray for reasons of record. The rejection based on McMichael 6,100,244 in view of Murray has been withdrawn based on the terminal disclaimer filed 9-24-01. Applicants arguments regarding the double patenting rejection of claims 8-14 are dependent upon the newly suggested language limiting the symptom of constriction of airways. Applicants arguments are moot because the amendment has not been entered.